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Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Request for Telephone Interview

Applicant's agent, Robert H. Frantz, requests a telephone interview with the examiner prior to issuance of the next Office Action in order to answer any questions the examiner may have, and to consider any suggestions the examiner may make. Mr. Frantz can be reached at 405-812-5613 at the examiner's convenience.

Objections to the Specification

In the Office Action, the examiner has objected to pages 1 and 2 of the specification for referring to references without any associated numbers. The present amendment places into the Cross-References and Incorporation by Reference sections the USPTO-assigned serial numbers and filing dates for the related patent applications.

Rejections under 35 U.S.C. §103

In the Office Action, the examiner has rejected claims 1, 10, and 19, our independent claims, under 35 U.S.C. §103(a) as being unpatentable over US Patent 5,946,665 to Suzuki (hereinafter "Suzuki") in view of US Published Patent Application 2002/0095465 A1 by Banks (hereinafter "Banks").

By use of the term "online shopper", we mean person or user of an online shopping resource such as a virtual mall, in accordance with the commonly used term "shopper":

shopper: One who visits stores in search of merchandise or bargains.
(www.dictionary.com)

By use of the term "online shop", "virtual shop" and "virtual mall", we mean a portion of an online shopping resource such as a virtual mall through which items may be viewed and/or

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purchased, in accordance with the commonly used term "shop", but which does not have a geographical or physical location associated with the online shopping experience:

shop: A small retail store or a specialty department in a large store.
(www.dictionary.com)

E-tailing or The Virtual Storefront and the Virtual Mall: As a place for direct retail shopping, with its 24-hour availability, a global reach, the ability to interact and provide custom information and ordering, and multimedia prospects, the Web is rapidly becoming a multibillion dollar source of revenue for the world's businesses. A number of businesses already report considerable success. As early as the middle of 1997, Dell Computers reported orders of a million dollars a day. By early 1999, projected e-commerce revenues for business were in the billions of dollars and the stocks of companies deemed most adept at e-commerce were skyrocketing. Although many so-called dotcom retailers disappeared in the economic shakeout of 2000, Web retailing at sites such as Amazon.com, CDNow.com, and ComputataOnline.com continues to grow. (Excerpted from www.whatis.com definition for "e-commerce", emphasis added).

With respect to Suzuki's disclosure:

(a) Suzuki discloses:

"The search means 2 responds to a customer's request provided via a client terminal, thus **searches the store index database 5** for requested information, uses the thus-obtained information to produce information (such as a **list of stores** and so forth, for example), sends the produced information to the client terminal which then indicates the sent information to the customer."

The cyber-mall indication means 3 responds to a customer's request provided via a client terminal, searches the store index database 5 for requested information (such as visual information about a virtual cyber-mall and so forth) in which image data of stores is combined and indicated as a mall and detailed visual information (about a virtual cyber-street) of a store which has been selected from the stores of the virtual cyber-mall), sends the thus-obtained information to the client terminal which then indicates the sent information to the customer." (col. 3 lines 34- 43, emphasis added)

- (b) Suzuki discloses that a list of stores and malls (Abstract lines 5-7), not a list of *other users or shoppers*. Suzuki's list of stores and malls is generated for customers when the customer is seeking a specific item to purchase, which is not the same as our process which allows users to see which other *shoppers* (not stores) are concurrently using or "visiting" the virtual mall.
- (c) Suzuki discloses a search method that access the *store index* database (col. 3 lines 26-32), not an online *shopper* index. This is not the same as our process which allows one shopper to interact *with other online shoppers* who are within their "buddy list" (e.g. our process produces a list of other *shoppers* and their virtual locations within the virtual mall).
- (d) In Figure 8, Suzuki discloses a graphical representation of an location of a *virtual shop*, but not the virtual location of another shopper, which is not the same as our process which shows the virtual locations of *shoppers*.
- (e) Suzuki describes (col. 5, lines 26 - 48, Fig. 2) their process as searching for *store conditions*, not for particular shoppers or users, in a store index in step S2, and then creating a store list (not a shopper list) in step S3, which is not the same as our invention which creates a virtual association of online *shoppers* regardless of store conditions and store locations. Further, Suzuki discloses in Figure 1 a "store index database", but does not show a index or database of online users or online

shoppers.

With respect to Banks' disclosure, which relates to chat servers (emphasis added):

[0064] Certain embodiments of the present invention have been described herein that use a database search to determine if the mobile user and/or information device has any **geographically matching** chat servers. A similar technique can be used to identify chat servers, chat groups, chat sessions, other information devices, and/or other users that match other attributes specified for and/or by the user and/or device.

[0065] One embodiment of the present invention uses **dietary- and/or health-related state variables of the user to match chat servers, groups, and/or sessions**. Such an embodiment can be used, for example, to link a patient to chat sessions that encourage the patient to take medications when the patient's blood sugar level drops below a particular level. As another example, a simple device can be used to monitor water retention in the body, which is a primary factor in predicting heart attacks. When conditions of high water retention exist, users can be invited into, and/or connected to, one or more chat sessions that discuss the problem. Note that this embodiment can be used independently of any location information.

[0066] Other examples of state variable-driven systems based on this embodiment can include **trading systems, dating systems, and news feed systems**. For example, a trading chat system, such as a **rare coin** chat system, can notify a user when a coin becomes available having identical and/or similar attributes as those specified by the user and can initiate a chat session between the user and the seller of the coin, and/or between those with interest in such coins. As another example, a **dating chat system** can notify a first user when a second user become available having self-attributes and/or partner-attributes identical and/or similar to those specified as desirable by the first user, and can initiate a chat session between these users. As yet another example, a **news chat system** can notify a user upon the occurrence of a news event, and can offer to connect the user to a chat group of others potentially

interested in the same topic. Such news events can include, for example, the beginning of a sporting event, an announcement of a court decision, and/or the reporting of a catastrophe, etc.

- (f) Banks discloses a method for an information device to participate in a *chat session* based upon state variables, examples of which include dietary conditions, dating, coin trading, and news discussion groups. This is not the same as our invention that provides a *dynamically created association of online shoppers* of a common shopping resource. For example, to use Banks's chat room invention, one must register into a dating system, news chat group, etc., in order to establish Banks's "state variables". Thus, all previously registered chat room participants are previously associated with each other (e.g. they all have registered for the "rare coin trading" group). Our invention, however, is unrelated to chat rooms, but instead allows users of online shopping resources such as virtual shopping malls to dynamically associate with each other. It facilitates notification of users that their "buddies" are concurrently using the same online shopping resource.
- (h) Banks discloses (paragraph [0019]) that certain *physical or real geographic* factors may be employed in relation to chat group membership (emphasis added):

[0019] FIG. 1 is a flowchart of an exemplary embodiment of a method 100 of the present invention. Method 100 can begin at activity 1010, wherein a mobile information device ("MID") is detected in a chat server's **geographical area**. This location detection can occur using any of many well known techniques and/or technologies, such as for example, **power attenuation, angle of arrival, time difference of arrival, triangulation, trilateration, dead reckoning, odometrics, radio beacons, GPS, Loran, infrared beacons,**

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proximity beacons, roadside readers, the Federal Communications Commission's Enhanced 911 initiative, etc. ...

However, our invention does not locate other shoppers based upon their *real or geographic* location, but upon their *virtual location* in a virtual shopping mall. To do this, each shopper's virtual location is determined by the online store (e.g. point within a web site structure) which the shopper is currently viewing or using.

Banks is silent as to such formation or dynamic association of online shoppers relative to their virtual location defined as their instant point within an online store in an online mall.

We have amended our claims to recite and specify these differences between Suzuki and Banks. In view of this amendment, we request that the rejections of the claims, including the dependent claims which inherit these distinctions, for the following reasons:

1. The combination or modification of the references in the manner suggested by the examiner does not teach all the claimed elements, steps, or restrictions. MPEP §2143.03 states:

All Claim Limitations Must Be Taught or Suggested. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

The facts derived from the references and set forth below indicate that the examiner's suggested combination and modification of the cited references does not teach all claimed elements, limitations or step. Therefore, the rejection is unsupported by the art and should be withdrawn.

- i. searching a list of concurrently online shoppers (*not shops*) according to a set of search criteria wherein the shoppers are simultaneously using a virtual shopping resource and wherein they

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- are previously disassociated with each other (claims 1, 10, 19);
- ii. notifying a first online shopper that at least one other concurrently online shopper meets the search criteria (not that a shop meets search criteria) (claims 1, 10, and 19); and
 - iii. automatically associating the first online shopper with one or more found concurrently online shoppers (not based upon a physical or geographical location, membership in a chat group, or store criteria) (claims 1, 10, and 19).

2. Motivation or suggestion to modify Suzuki or Banks to incorporate the distinctive elements, steps or limitations recited in (1) is not made by either disclosure.

MPEP §2143.01 states:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Therefore, it would not have been obvious to someone ordinarily skilled in the art to make the invention, as claimed in view of the present amendment, at the time the invention was made.

Conclusion

The rejections are not supported by the cited art in view of the amendment made herein. Allowance of the claims as amended is requested.

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